

Application No. 10/705,533

Reply to Office Action

*REMARKS**The Pending Claims*

Claims 1-8 and 13-27 are currently pending. Claims 15-25 have been withdrawn.

Amendments to the Claims

Claim 1 has been amended to more particularly point out that which Applicant considers his invention. Specifically, claim 1 has been amended to (a) recite that the polishing pad is in the form of micropellets of the biodegradable polymer dispersed in a non-biodegradable polymer resin and (b) to add the limitation of monosaccharides as a possible repeat unit. Claims 14, 26 and 27 have been canceled. Support for the amendment of claim 1 can be found in the instant specification at paragraph [0009]. No new matter has been added by way of these amendments.

Summary of the Office Action

Claims 1-5 and 13 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent 5,470,944 (Bonsignore) (hereinafter "Bonsignore").

Claims 1-8, 13, and 26-27 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Publication 2003/0054735 (Mirsa et al.), in view of U.S. Patent Application Publication 2003/0124958 (Hirai et al.) and Bonsignore.

The Office Action has stated that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, because the prior art of record fails to teach or suggest this limitation.

Discussion of the Section 102/103 Rejections

The anticipation and/or obviousness rejections under Bonsignore are moot in view of the amendments to the claims.

In order to anticipate the pending claims, Bonsignore must teach each and every element of the claims. As conceded on page 5 of the present Office Action dated October 10,

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2006, Bonsignore fails to disclose the limitations as recited in the amended claim.

Accordingly, Bonsignore does not anticipate the pending claims.


The obviousness rejection in view of Bonsignore likewise is improper. Since Bonsignore fails to teach or suggest all of the claim limitations, i.e., a polishing pad in the form of micropellets of the biodegradable polymer dispersed in a non-biodegradable polymer resin, a *prima facie* case of obviousness has not been established.

The obviousness rejections under Mirsa et al. are moot in view of the amendments to claim 1. Since Mirsa et al., Hirai et al. and Bonsignore fail to teach or suggest each and every element of the pending claims, either separately or in combination, the obviousness rejection is improper and should be withdrawn.

Conclusion

Applicant respectfully submits that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned representative.

Respectfully submitted,


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